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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BELL, BOYD & LLOYD, LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER	
MOORE JR, MICHAEL J	

ART UNIT	PAPER NUMBER
2666	

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/827,487	BRUMM ET AL.	
	Examiner	Art Unit	
	Michael J. Moore, Jr.	2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 January 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/9/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 9/9/2002 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

Drawings

2. The drawings are objected to because of the following informalities: In Figure 2, element 20a, which is labeled "ISON – TERMINAL", should be "ISDN – TERMINAL". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims **1, 4, 9, 24, and 26** are objected to because of the following informalities:

Regarding claim **1**, on line 3, the phrase "can be connected" should be changed to "is connected" in order to constitute a positive limitation. On line 5, the phrase "can be used" should be changed to "is used" in order to constitute a positive limitation. Also, on line 7, the word "to" after the word "both" is not needed. Also, on line 8, the word "to" after the word "and" is not needed.

Regarding claim **4**, on line 4, the word "message" should be "messages".

Regarding claim **9**, on line 2, the phrase "in claims 3" should be "in claim 3".

Regarding claim **24**, on line 1, the phrase "can be connected" should be changed to "is connected" in order to constitute a positive limitation.

Regarding claim **26**, on line 1, the phrase "can be connected" should be changed to "is connected" in order to constitute a positive limitation.

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim **1** is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim **3** of copending Application No. 09/827433. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following correspondences:

Regarding claim **1** of the instant application, "at least one telecommunications device which can be connected to a line-switching communications network" corresponds to a network element of a circuit-switching communications network" in claim **3** of the copending application. "A packet-switching communications network which can be used to transmit first data between a first subscriber line and a second subscriber line of the packet-switching communications network" corresponds to "a packet-switching communications network" as well as "at least a first subscriber connected to the packet-switching communications network" in claim **3** of the copending application.

"An interface unit connected to both the packet-switching communications network and the telecommunications device" corresponds to "a network element of a circuit-switching communications network connected to the packet-switching communications network using an interface unit". Lastly, "the interface unit converting at least some of the first data, which is intended for the subscriber line using the packet-switching communications network, into second data of the line-switching communications network, and feeding the second data to the telecommunications

device, and vice versa" corresponds to "wherein a portion of the first signaling information is converted into second signaling information using the interface unit and is transmitted as second signaling information between the interface unit and the first subscriber" in claim **3** of the copending application.

Although these claims are worded differently, the scope encompassed by the limitations of these claims is the same. The difference in wording between these claims would be obvious to someone skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims **1-16, 18, 19, 21-23, 26, and 27** are rejected under 35 U.S.C. 102(e) as being anticipated by Rose et al. (U.S. 6,396,840) ("Rose"). Rose teaches all of the limitations of the listed claims with the reasoning that follows.

Regarding claim **1**, "a system for connecting a telecommunications device to a packet-switching communications network" is anticipated by the integrated system architecture shown in Figure 5 connecting subscriber terminal 119 (device) to LAN 10

(packet-switching network). "At least one telecommunications device which can be connected to a line-switching communications network" is anticipated by subscriber terminal 119 (device) that is connected to exchange 118 (line-switching network) as shown in Figure 5.

"A packet-switching communications network which can be used to transmit first data between a first subscriber line and a second subscriber line of the packet-switching communications network" is anticipated by LAN 10 of Figure 5 that communicates with multi-media endpoint 110. "An interface unit connected to both the packet-switching communications network and the telecommunications device" is anticipated by gateway interface 112 (interface unit) of Figure 5 connected to both LAN 10 (packet-switching network) and subscriber terminal 119 (device).

Lastly, "the interface unit converting at least some of the first data, which is intended for the subscriber line using the packet-switching communications network, into second data of the line-switching communications network, and feeding the second data to the telecommunications device, and vice versa" is anticipated by gateway interface 112 of Figure 6 that translates incoming H.225 call signaling (first data) from LAN 10 into DSS1 broadband format (second data) for onward routing as spoken of on column 8, lines 53-65.

Regarding claim **2**, "wherein the first and second data are user data" is anticipated by the audio 28, video 30, and data 32 (first data) as well as the mini-channel format data output 134 (second data) shown in Figure 6 and spoken of on column 8, lines 59-65.

Regarding claim **3**, "wherein the first and second data are signaling data which contain signaling messages" is anticipated by the H.225 RAS 22, H.225 call signaling 14, and H.245 negotiation control 26 (first data) as well as call signaling 114 (second data) shown in Figure 6 and spoken of on column 8, lines 53-59.

Regarding claim **4**, "wherein the interface unit, via an interface program, converts the signaling messages of the packet-switching communications network into equivalent signaling messages of the line-switching communications network" is anticipated by gateway interface 112 of Figure 6 that translates incoming H.225 call signaling (signaling messages) from LAN 10 (packet network) into DSS1 broadband format (signaling messages) for onward routing as spoken of on column 8, lines 53-65.

Regarding claim **5**, "wherein the conversion is carried out using equivalent signaling messages stored in a database" is anticipated by memory 154 of gateway interface 112 of Figure 6 that contains look-up tables (database) associated with signaling protocol translation schemes used to translate LAN signaling to narrowband/broadband signaling as spoken of on column 8, line 66 – column 9, line 5.

Regarding claim **6**, "wherein the interface program for signaling messages to which no equivalent signaling message is assigned is transmitted using a data packet as user data" is anticipated by gateway interface 112 of Figure 6 that translates incoming H.225 call signaling (signaling messages) from LAN 10 (packet network) into DSS1 broadband format (signaling messages) for onward routing as spoken of on column 8, lines 53-65.

Regarding claim **7**, "wherein the interface program generates messages which at least one of the packet-switching communications network and the line-switching communications network requires as an acknowledgement of transmitted signaling data" is anticipated by a message confirming the trunk circuit identity sent from next exchange 118 to call handler 116 in response to a setup signaling message sent from call handler 116 to next exchange 118 as spoken of on column 10, lines 24-36.

Regarding claim **8**, "wherein the signaling messages are used to make connection setups between the first and second subscribers" is anticipated by call signaling messages 114 that are used to set-up and clear-down calls as spoken of on column 7, lines 53-56.

Regarding claim **9**, "wherein the signaling messages are used for at least one of activating, deactivating, and registering at least one service feature" is anticipated by the H.225 RAS (registering, admission, and status) signaling shown in Figure 6.

Regarding claim **10**, "wherein the service feature comprises at least one of call pick-up, three-way conferencing, large-scale conferencing, holding, displaying of toll information, a closed user group, call number identification, automatic callback when busy, automatic callback when no response, call barring, an indication of call waiting and call transfer" is anticipated by call signaling information 114 containing an address of a called party (call number identification) as spoken of on column 9, lines 13-18.

Regarding claim **11**, "wherein the signaling messages are transmitted in the packet-switching communications network independently of user connections" is anticipated by gateway interface 112 of Figure 6 that translates incoming H.225 call

signaling (signaling messages) from LAN 10 (packet network) into DSS1 broadband format (signaling messages) for onward routing as spoken of on column 8, lines 53-65.

Regarding claim **12**, "wherein the signaling message of the line-switching communications network are DSS1 messages which are defined in the ITU Standards Q.931 and Q.932" is anticipated by the DSS1 signaling format spoken of on column 8, lines 53-59.

Regarding claim **13**, "wherein the signaling messages of the packet-switching communications network are signaling messages of the H.225 signaling protocol Standard" is anticipated by the H.225 RAS 22 and H.225.0 call signaling 14 spoken of on column 8, lines 44-49.

Regarding claim **14**, "wherein the telecommunications device is at least one of an ISDN telephone, an analog telephone, an analog modem, an ISDN modem and an analog facsimile device" is anticipated by subscriber terminal 119 of Figure 5 that utilizes ISDN broadband communication as spoken of on column 7, lines 50-62.

Regarding claim **15**, "wherein the telecommunications device is a private branch exchange" is anticipated by the exchange 118 shown in Figure 5.

Regarding claim **16**, "wherein the interface unit is arranged in a separate physical unit" is anticipated by gateway interface 112 shown in Figure 5.

Regarding claim **18**, "wherein a control unit of the interface unit automatically logs on the interface unit as a subscriber to the packet-switching communications network" is anticipated by the gateway interface 112 operating as a subscriber as spoken of on column 12, lines 11-16.

Regarding claim **19**, "wherein the interface unit has a control unit which converts the data using at least one program module" is anticipated by gateway interface 112 shown in Figure 5.

Regarding claim **21**, "an interface unit which is connected both to a packet-switching communications network and to a telecommunications device which is provided for connection to a line-switching telecommunications network" is anticipated by gateway interface 112 (interface unit) of Figure 5 connected to both LAN 10 (packet-switching network) and subscriber terminal 119 (device). Lastly, "a control unit which converts at least one item of signaling information of the packet-switching communications network into an item of signaling information of a line-switching communications network and feeds it to the telecommunications device, and vice versa" is anticipated by processor 152 (control unit) of gateway interface 112 of Figure 6 that translates incoming H.225 call signaling (signaling information) from LAN 10 (packet network) into DSS1 broadband format (signaling information) for onward routing as spoken of on column 8, lines 53-65.

Regarding claim **22**, "wherein the interface unit is used to connect a communications terminal to the packet-switching communications network" is anticipated by gateway interface 112 (interface unit) of Figure 5 connected to both LAN 10 (packet-switching network) and subscriber terminal 119 (terminal).

Regarding claim **23**, "wherein the interface unit is used to connect a private branch exchange to the packet-switching communications network" is anticipated by

gateway interface 112 (interface unit) of Figure 5 connected to both LAN 10 (packet-switching network) and exchange 118.

Regarding claim **26**, "a private branch exchange which can be connected to a line-switching communications network and which is used for telecommunications" is anticipated by exchange 142 (private branch exchange) of Figure 5 connected to exchange 118 (line-switching network). "An interface unit which is connected both to a packet-switching communications network and to a telecommunications device which is provided for connection to a line-switching telecommunications network" is anticipated by gateway interface 112 (interface unit) of Figure 5 connected to both LAN 10 (packet-switching network) and subscriber terminal 119 (device).

"A control unit which converts at least one item of signaling information of the packet-switching communications network into an item of signaling information of a line-switching communications network and feeds it to the telecommunications device, vice versa" is anticipated by processor 152 (control unit) of gateway interface 112 of Figure 6 that translates incoming H.225 call signaling (signaling information) from LAN 10 (packet network) into DSS1 broadband format (signaling information) for onward routing as spoken of on column 8, lines 53-65. Lastly, "wherein the interface unit is used to connect the private branch exchange to the packet-switching communications network" is anticipated by gateway interface 112 (interface unit) of Figure 5 connected to both LAN 10 (packet-switching network) and exchange 118.

Regarding claim **27**, "wherein the interface unit is a module of the private branch exchange" is anticipated by gateway interface 112 shown in Figure 5 contained within exchange 142.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims **17, 24, and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose et al. (U.S. 6,396,840) ("Rose").

Regarding claim **17**, Rose teaches the system of claim **1**. Rose does not explicitly teach that the interface unit is a module in a telecommunications unit. However, Rose teaches gateway interface 112 (interface unit) shown in Figure 5 that is a module within exchange 142. At the time of the invention, it would have been obvious

to someone skilled in the art to modify the teachings of Rose by placing the interface module in the telecommunications unit rather than in the exchange in order to provide a direct connection between the telecommunications unit and the packet network.

Regarding claims **24 and 25**, Rose teaches gateway interface 112 (interface unit) of Figure 5 connected to both LAN 10 (packet-switching network) and subscriber terminal 119 (device). Rose also teaches processor 152 (control unit) of gateway interface 112 of Figure 6 that translates incoming H.225 call signaling (signaling information) from LAN 10 (packet network) into DSS1 broadband format (signaling information) for onward routing as spoken of on column 8, lines 53-65. Rose does not explicitly teach that the interface unit is a module within a communications terminal. However, Rose teaches gateway interface 112 (interface unit) shown in Figure 5 that is a module within exchange 142. At the time of the invention, it would have been obvious to someone skilled in the art to modify the teachings of Rose by placing the interface module in the communications terminal rather than in the exchange in order to provide a direct connection between the communications terminal and the packet network.

11. Claim **20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rose et al. (U.S. 6,396,840) ("Rose") in view of Cannon et al. (U.S. 6,735,209) ("Cannon").

Regarding claim **20**, Rose teaches the system of claim **1**. Rose does not teach a packet-switching network based on an Internet protocol. However, Cannon teaches a similar data conversion method as shown in Figure 2 where a gateway 39 (interface unit) converts signaling and data information between a PSTN and an IP network. At the time of the invention, it would have been obvious to someone skilled in the art given

these references to modify the teachings of Rose for use with an IP network rather than a LAN in order to provide IP telephony services to a PSTN as spoken of on column 1, lines 45-56 of Cannon.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schuster et al. (U.S. 6,674,745), Schuster et al. (U.S. 6,650,619), Elliott et al. (U.S. 6,614,781), Douglas et al. (U.S. 6,363,424), and Brumm et al. (U.S. 2002/0054590) are all references that contain material pertinent to this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Moore, Jr. whose telephone number is (571) 272-3168. The examiner can normally be reached on Monday-Friday (8:30am - 5:00pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached at (571) 272-3174.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael J. Moore, Jr.
Examiner
Art Unit 2666

mjm MM

FRANK DUONG
PRIMARY EXAMINER